

## REMARKS

Claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66 are pending in the present application. By this Amendment, previously presented claims 1, 3, 6-8, 12, 14-15, 18, 20-22, 46 and 48 are amended; previously presented claims 4-5, 13, 19 and 47 are cancelled; and new claims 52-66 are added. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendment and the following remarks.

### I. Prior Art Rejections:

#### Rejection of Previously Presented Claims 1-11, 46-49 and 51 Under 35 U.S.C. §103(a) in View of Gajewski In Combination With Wheatley

Previously presented claims 1-11, 46-49 and 51 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,208,080 to Gajewski et al. (hereinafter, "Gajewski") in view of U.S. Patent No. 6,049,419 to Wheatley et al. (hereinafter, "Wheatley"). This rejection is respectfully traversed.

Each of the teachings of Gajewski and Wheatley fail to teach, disclose or suggest Applicants' claimed invention as embodied in the presently presented claims. Regarding independent claim 1, each of the teachings of Gajewski and Wheatley fail to teach, disclose or suggest a laminate comprising a transparent optical sheet positioned between first and second bonding sheets so that portions of opposing major surfaces of the first and second bonding sheets, adjacent their peripheral edges, extend beyond the peripheral edge of the optical film, face one another, and either have an unfilled space therebetween or contact one another. In contrast to Applicants' claimed invention in independent claim 1, Gajewski discloses a laminate that requires spacers 18 positioned between thermoplastic laminating layers 14 and 24 and surrounding at least a portion of semi-rigid sheet 20 (see FIGS. 1-2). In the Gajewski laminates, spacers 18 occupy the space between thermoplastic laminating layers 14 and 24, and prevent the peripheral edges of thermoplastic laminating layers 14 and 24 from contacting one another.

Regarding independent claim 46, each of the teachings of Gajewski and Wheatley fail to teach, disclose or suggest a kit for making a laminate, wherein the kit comprises a transparent optical sheet comprising a non-metallic birefringent multi-layer

optical film and the optical sheet is dimensioned so as to extend beyond the peripheral edge of at least one glazing component to which the optical sheet is to be adhered. In contrast to Applicants' claimed invention in independent claim 46, Gajewski discloses a laminate that requires semi-rigid sheet 20 to be positioned within outer peripheries of rigid transparent material layers 12 and 22 (see FIGS. 1-4).

For at least the reasons given above, Applicants respectfully submit that the proposed combination of the teaching of Gajewski with the teaching of Wheatley, even if proper, fails to make obvious Applicants' claimed invention as recited in independent claims 1 and 46. Since claims 2-3, 6-11, 48-49 and 51 depend from independent claims 1 and 46 and recite additional claim features (previously presented claims 4-5 and 47 have been cancelled), the proposed combination of the teaching of Gajewski with the teaching of Wheatley also fails to make obvious dependent claims 2-3, 6-11, 48-49 and 51. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection of Previously Presented Claims 12-22 and 50 Under 35 U.S.C. §103(a) in View of Gajewski In Combination With Wheatley and Frost

Previously presented claims 12-22 and 50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gajewski in view of Wheatley, and further in view of U.S. Patent No. 6,352,754 to Frost et al. (hereinafter, "Frost"). This rejection is respectfully traversed.

The teaching of Frost is directed to a method of forming a laminated glass sheet, wherein the laminated glass sheet comprises a multilayer intermediate film having a thin metallic layer or stack of metallic layers having thermal properties sandwiched between two plies of a polymeric bonding material. The disclosed method includes (a) forming an incision through one of the outer layers of polymeric bonding material and the thin metallic layer or stack of metallic layers along a peripheral edge of the intermediate film; (b) placing the incised intermediate film between rigid substrates (e.g., glass plates); (c) removing the outer zone of incised thin metallic layer or stack of metallic layers from between the rigid substrates using a pull tab; and (d) heating the laminate to bond the layers to one another.

It should be noted that the method of Frost is primarily designed to avoid corrosion of the thin metallic layer or stack of metallic layers having thermal properties.

In order to avoid corrosion of the metallic layer(s), a peripheral edge portion of the thin metallic layer or stack of metallic layers is removed prior to a final laminating step. See, for example, Frost, column 1, lines 29-64; column 4, line 58 to column 5, line 19; column 6, lines 18-26; and column 11, lines 24-47.

The disclosed method of forming a laminate in Frost differs substantially from the assembly method of forming a laminate as disclosed in Gajewski. As discussed above, Gajewski discloses a method in which spacers 18 are positioned next to semi-rigid sheet 20 such that spacers 18 and semi-rigid sheet 20 are sandwiched between thermoplastic laminating layers 14 and 24, which are sandwiched between rigid transparent material layers 12 and 22 (see FIGS. 1-4). The disclosed method of Gajewski, thus, requires the use of polymeric bonding material spacers 18 as an essential part of the Gajewski invention. In contrast to Frost, the disclosed method of Gajewski does not require or suggest the need or desire to incise one or both of the thermoplastic laminating layers 14 and 24. Further, the disclosed method of Gajewski is not at all concerned with potential corrosion of semi-rigid layer 20 given that semi-rigid layer 20 is a polymer layer, not a metallic layer.

Examiner Nordmeyer suggests that one skilled in the art, given the teaching of Gajewski, would have been motivated to seek out the teachings of Wheatley and Frost, and then modified the disclosed laminates of Gajewski by substituting a non-metallic birefringent multi-layer optical film, as disclosed in Wheatley, for the semi-rigid sheet 20 used in the laminates of Gajewski, and then modify the disclosed method of forming the resulting laminate (i.e., containing the non-metallic birefringent multi-layer optical film of Wheatley) using the incision method disclosed in Frost. Applicants disagree.

Applicants respectfully submit that the proposed combination of select portions of the teachings of Gajewski, Wheatley and Frost is improper. There is no suggestion in Gajewski of the need or desire to substitute the incision method of making laminates, as disclosed in Frost, for the assembly method disclosed in Gajewski as suggested by Examiner Nordmeyer. The disclosed method of Gajewski requires, as an essential part of the Gajewski invention, the use of polymeric bonding material spacers 18. The Frost incision method would eliminate such spacers 18. As noted by the Court

in *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), the modification of a prior art reference so as to change the principle of operation of the reference has been frowned upon. As stated by the Court in *In re Ratti*, “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *Id.*

Applicants respectfully submit that the removal of polymeric bonding material spacers 18 from the teaching of Gajewski as proposed by Examiner Nordmeyer significantly changes the principle of operation of Gajewski, namely, an assembly method in which spacers 18 are used to at least partially surround semi-rigid layer 20 prior to a laminating step. For at least this reason, Applicants respectfully submit that the proposed combination of select portions of the teachings of Gajewski, Wheatley and Frost, and the proposed modification of the teaching of Gajewski is improper.

Further, Applicants respectfully submit that the only motivation for modifying the disclosed laminates of Gajewski, as well as the disclosed method for making the Gajewski laminates has been gleaned from Applicants’ original specification, not from what is taught or suggested in the art of record. As stated by the Court, “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention”, *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). For at least this reason, Applicants respectfully submit that the proposed combination of select portions of the teachings of Gajewski, Wheatley and Frost is improper.

For at least the reasons given above, Applicants respectfully submit that the proposed combination of the teaching of Gajewski with the teachings of Wheatley and Frost is improper and that Examiner Nordmeyer has failed to make a *prima facie* case of obviousness. For at least the reasons given above, the proposed combination of the teaching of Gajewski with the teachings of Wheatley and Frost fails to make obvious Applicants’ claimed invention as recited in claims 14-18, 20-22 and 50 (previously presented claim 13 and 19 have been cancelled). Accordingly, withdrawal of this rejection is respectfully requested.

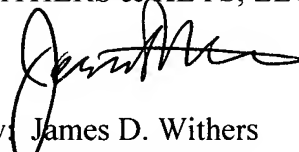
II. Conclusion:

For at least the reasons given above, Applicants submit that claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should Examiner Nordmeyer believe that anything further is necessary to place the application in better condition for allowance, Examiner Nordmeyer is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,  
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3M Docket No.: 56995US002